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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/076,416

02/19/2002

Mechthild Rieping

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EXAMINER

STEADMAN, DAVID J

ART UNIT

PAPER NUMBER

1656

NOTIFICATION DATE

DELIVERY MODE

03/20/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Advisory Action Before the Filing of an Appeal Brief	Application No. 10/076,416	Applicant(s) RIEPING ET AL.	
	Examiner David J. Steadman	Art Unit 1656	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 February 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): see box 11.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: 25-28, 33 and 35-42.
- Claim(s) rejected: 23.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/David J. Steadman/
Primary Examiner, Art Unit 1656

Continuation of 11. does NOT place the application in condition for allowance because: The request for reconsideration in the response filed on 2/28/08 is acknowledged. Applicant's arguments filed on 2/28/08 in response to the final Office action mailed on 11/30/07 have been fully considered, however, the claims are not in condition for allowance for reasons that follow.

The written description and scope of enablement rejections of claims 23, 25-28, 33, and 39-42 under 35 U.S.C. 112, first paragraph, are withdrawn in view of applicant's amendment to claim 23 to recite the limitation "and wherein the modified *Escherichia*...as compared to an unmodified *Escherichia microorganism*".

The obviousness-type double patenting rejection of claim 23 as being unpatentable over claim 5 of US Patent 7,241,600 or claim 3 of US Patent 7,172,883 is maintained for the reasons of record and the reasons set forth below. The rejection was fully explained in a prior Office action. See particularly paragraph 8, parts [i] and [m] at p. 13 of the Office action mailed on 10/19/05 and paragraph 9 at p. 7 of the Office action mailed on 11/30/07.

RESPONSE TO ARGUMENT: Regarding the '600 patent, applicant argues: 10/481,745 [i] has issued as US patent no. 7,241,600 and claims a process involving phosphoenol pyruvate protein phosphotransferase (ptsI) not *poxB* as in the present claims. Pts 1 is also not identified in the present claims. Further, the claim cited in the '745 application and that was the basis for the rejection is not present in the issued patent. Withdrawal of the rejection for this patent is requested. Regarding the '883 patent, applicant argues: 10/481,746 [m] has issued as US patent no. 7,172,883 and claims a process involving *ahpC* and *ahpF* not *poxB* as in the present claims, *ahpC* and *ahpF* are also not identified in the present claims. Further, the claim cited in the '746 application and that was the basis for the rejection is not present in the issued patent. Withdrawal of the rejection for this patent is requested.

Applicant's argument is not found persuasive. The conflicting claims originally noted in the provisional rejections set forth in the Office action mailed on 10/19/05 are present in the respective issued patents, which are drawn to (in relevant part) a method for making an L-amino acid using an *Escherichia* host cell with deleted or reduced expression of *poxB*.

The provisional obviousness-type double patenting rejection is maintained for the reasons of record and the reasons stated below. The rejection was fully explained in the prior Office action. See particularly paragraph 11 at pp. 11-16 of the Office action mailed on 10/19/05 and paragraph 8 at p. 6 of the Office action mailed on 11/30/07.

RESPONSE TO ARGUMENT: Applicant requests the remaining provisional rejections be held in abeyance with respect to the remaining applications.

Applicants' argument is not found persuasive. As to the remaining co-pending applications that are not abandoned or issued, the provisional rejection is maintained.

The examiner reminds applicant that an earnest attempt has been made to identify those patents and/or co-pending applications for purposes of rejecting or provisionally rejecting the claims for double patenting. However, it is noted that numerous co-pending applications have been filed and/or continue to be filed, and/or patents have issued disclosing subject matter that is related to the instant application. In the interest of compact prosecution, the examiner requests that: 1) applicants identify any patent(s) and/or co-pending application(s) that claim(s) subject matter that may necessitate a double patenting rejection, an obviousness-type double patenting rejection, a provisional double patenting rejection, or a provisional obviousness-type double patenting rejection; 2) identify the claims of the patents and/or co-pending applications that claim identical or similar subject matter; 3) identify the corresponding claims of the instant application, and 4) take the appropriate action, e.g., cancel claims to preempt a statutory double patenting rejection and/or file a terminal disclaimer to preempt an obvious-type double patenting rejection or provisional rejection. Applicant's cooperation in following steps 1) to 4) above is appreciated as this will allow the examiner to focus on more substantive issues in the examination of the instant application.